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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUN LIN, NAVJOT VIRK, BRIAN S. AUST,
SHISHIR P. PARDIKAR, DAVID C. STEERE,
and MOHAMMED A. SAMJI

Appeal 2007-4505
Application 10/692,212
Technology Center 2100

Decided: June 23, 2008

Before JEAN R. HOMERE, JAY P. LUCAS and
THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 1, 3-22, 24, 25, 36, 37, 39, and 40. We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

According to Appellants, the invention provides a client side caching infrastructure that supports transition states at the directory level to facilitate a seamless operation across connectivity states between client and remote server. Persistent caching is performed to safeguard the user and/or the client applications across connectivity interruptions and/or bandwidth changes. This is accomplished in part by caching to a client data store the desirable files together with the appropriate file access parameters. Moreover, the client maintains access to cached files during periods of disconnect. Furthermore, portions of a path can be offline while other portions upstream can remain online (Spec., Abstract).

B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. A remote file system, comprising:

one or more surrogate providers comprising at least a first surrogate provider that is a client side caching (CSC) component that selectively caches at least a subset of data from at least one online server and supports connection state transitions at the directory level on a logical namespace; and

one or more client computers that receive and store the subset of data to their respective local databases for offline use by the respective client computers to facilitate a seamless operation of data retrieval across connectivity states for a user, the offline use is limited to shares of the logical namespace that are experiencing a period of disconnect.

C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Domenikos	US 6,065,043	May 16, 2000
Murphy	US 6,096,096	Aug. 1, 2000
Shaw	US 2002/0083148 A1	Jun. 27, 2002 (filed Dec. 21, 2000)

Claims 1, 3-5, 7-16, 18-22, 24, 25, 36, 37, 39, and 40 stand rejected under 35 U.S.C. § 103(a) over the teachings of Domenikos and Murphy; and

Claims 6 and 17 stand rejected under 35 U.S.C. § 103(a) over the teachings of Domenikos, Murphy, and Shaw.

We affirm.

II. ISSUES

The issues are whether Appellants have shown that the Examiner erred in finding that

A. Claims 1, 3-5, 7-16, 18-22, 24, 25, 36, 37, 39, and 40 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Domenikos and Murphy.

B. Claims 6 and 17 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Domenikos, Murphy, and Shaw.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Domenikos

1. Domenikos discloses providing the client with access to a cache memory for cache storing portions of a file system which contain application programs (col. 3, ll. 55-61; fig. 3).
2. The processes can include the step of providing an offline page which is representative of at least one link to an application program stored within the cache memory (col. 4, ll. 18-23).

Murphy

3. Murphy discloses storing information for a particular Web site, previously only accessible to an online end-user to access the Web site information, on portable, offline accessible, storage media. Therefore, an offline end-user is allowed to access the Web site information in a manner which emulates online accessing of the Web site (col. 5, ll. 28-38).
4. The portable, offline Web site delivery system allows the content creator to selectively control the type and content of information presented to specific end-users. Hence, Murphy enables delivery of a customized portable, offline, Web site (col. 6, ll. 1-13).

IV. PRINCIPLES OF LAW

"Our analysis begins with construing the claim limitations at issue." *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (BPAI 2007). "[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

It is well settled that the recitation of an intended use for an old product does not make a claim to that old product patentable. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). Sullivan's crankshaft appears reasonably capable of use in a compressor and the Appellants have not shown that this is not the case. *See id.* at 1477.

Furthermore, "[a]n intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003).

V. ANALYSIS

Claims 1, 3-5, 7-16, 18-22, 24, 25, 36, 37, 39, and 40

Appellants argue that Domenikos and Murphy do not teach or suggest that "the offline use is limited to shares of the logical namespace that are experiencing a period of disconnect" as recited in independent claim 1 and

similarly recited in independent claims 21 and 36 (App. Br. 5; Reply Br. 2-3). Appellants assert that Murphy "stores the entire contents of the website on a storage medium for subsequent offline access" but is silent as to the offline use being "limited to shares of the logical namespace that are experiencing a period of disconnect" (App. Br. 6; Reply Br. 3). Appellants reference Appellants' own Specification and argue "[i]n accordance with the claimed invention, … [w]hen a connection state changes from online to offline due to a network disconnect, the CSC component will only transition to the cache the directory on the list that hosts to the object" (Reply Br. 3).

We disagree. The Examiner's position as to Domenikos and Murphy disclosing the claimed elements on appeal beginning at page 3 of the Answer and the Examiner's corresponding responsive arguments beginning at page 10 of the Answer meet all of the limitations required by independent claims 1, 21 and 36 on appeal.

The claims must be given their broadest reasonable interpretation, but limitations cannot be read into the claims from the Specification. Appellants' argument that the teachings of Murphy differ from the invention set forth in Appellants' Specification because Murphy "stores the entire contents of the Web site on a storage medium for subsequent offline access" is not commensurate with the invention that is claimed. That is, Appellants appear to be arguing that Murphy fails to disclose receiving and storing *only* a subset of data for offline use, wherein offline use is *at all times* limited to

shares of the logical namespace that are experiencing a period of disconnect, which is not commensurate with the claimed invention.

Murphy discloses storing information for a particular Web site on portable, offline accessible, storage media in a manner which emulates online accessing of the Web site, wherein the content creator can selectively control the type and content of information presented to specific end-users to enable delivery of a customized portable, offline, Web site (FF 3-4). Contrary to Appellants' assertion, Murphy does allow offline use to be limited, *including* offline use limited to shares of the logical namespace that are experiencing a period of disconnect. As the Examiner finds, Murphy discloses that "[t]he portable storage media is adapted to be used by an end-user in an offline environment" wherein "the information is arranged on the plurality of storage media such that offline accessing of the information emulates online accessing of the information" (Ans. 10-11). We agree with the Examiner that such "adapted" or "customized" use is limited offline use as set forth in the claims.

Furthermore, we find that the limited offline use is an intended use claimed without any structural element to provide such use, and thus, such intended use does not limit the scope of the claim. Murphy's portable storage media appears reasonably capable of offline use limited to shares of the logical namespace that are experiencing a period of disconnect, and the Appellants have not shown that this is not the case. Such intended use does

not limit the scope of the claim because it does no more than define a context in which the invention operates.

As to the other recited elements of claim 1, 21, and 36, Appellants provide no argument to dispute that the Examiner has correctly shown where all these claimed elements appear in the prior art. Thus, we deem those arguments waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

Claims 3-5, 7-16, 18-20, 22, 24, 25, 37, 39, and 40 depend from claims 1, 21, and 36 respectively, and thus fall with claims 1, 21, and 36. Accordingly, we conclude that the Appellants have not shown that the Examiner erred in rejecting claims 1, 3-5, 7-16, 18-22, 24, 25, 36, 37, 39, and 40 under 35 U.S.C. § 103(a).

Claims 6 and 17

As to claims 6 and 17, Appellants provide the same argument as claim 1 from which they depend, and add the argument that "Shaw, *et al*. does not make up for the aforementioned deficiencies of" Domenikos and Murphy (App. Br. 6; Reply Br. 4).

We find no deficiencies regarding Domenikos and Murphy, as discussed above regarding claim 1. Therefore, we conclude that Appellants have not shown that the Examiner erred in rejecting claims 6 and 17 under 35 U.S.C. § 103(a) over Domenikos, Murphy, and Shaw.

CONCLUSION OF LAW

(1) Appellants have not shown that the Examiner erred in finding that claims 1, 3-5, 7-16, 18-22, 24, 25, 36, 37, 39, and 40 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Domenikos and Murphy.

(2) Appellants have not shown that the Examiner erred in finding that claims 6 and 17 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Domenikos, Murphy, and Shaw.

(3) Claims 1, 3-22, 24, 25, 36, 37, 39, and 40 are not patentable.

DECISION

The Examiner's rejection of claims 1, 3-22, 24, 25, 36, 37, 39, and 40 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

pgc

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